REMARKS

In the Office Action, the Examiner indicated that claims 1 through 18 are pending in the application. The Examiner rejected claims 1 through18. In view of the Appeal Brief filed on April 25, 2008, prosecution has been reopened and new grounds for rejection have been presented.

The §101 Rejection

On page 2 of the Office Action, the Examiner has rejected claims 1-6 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant has amended the claims to specify that the invention in claims 1-6 is computer-implemented. It is submitted that this amendment overcomes the Examiner's rejection. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-6 under 35 U.S.C. §101

Claim Rejections, 35 U.S.C. §103

On page 3 of the Office Action, the Examiner rejected Claims 1 - 18, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 20020029201 to Barzilai et al. in view of U.S. Patent No. 6,697,824 to Bowman-Amuah

The Present Invention

In accordance with the present invention, parties involved in transacting business in an E-marketplace (E-marketplace participants) each identify and submit to the E-marketplace their P3P policy and/or other relevant characteristics related to their privacy policy needs (those that they adhere to, referred to as "privacy policies"; those that they require, referred to as "privacy preferences", or both). Submitted with the privacy policy is a digital signature that can be tied to the owner of the web objects to which the privacy policy pertains. Using a digital signature assures the integrity of the privacy policy since it travels with the privacy policy and thus refers back to the original sender of the policy rather than the middleman (the E-marketplace). Further, this method removes the onus on the SSL certificate owner to vouch for the privacy policy of the web objects hosted in a portal. Each of the claims include the requirement that the privacy policy be submitted with the digital signature.

The Examiner Has Not Established a Prima Facie Case of Obviousness

KSR (*KSR International Co. v. Teleflex Inc.,* 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." Further, an Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," In addition, the Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or

present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art."

The Examiner has not met these requirements. Applicant acknowledges that Bowman makes mention of the use of digital signatures and describes the well-known concept of the use of digital signatures in electronic transactions. Applicant acknowledged their existence in the specification, as well. Applicant des not claim to have invented the digital signature of its use in electronic transactions.

However, in an electronic marketplace, where there is a middleman (the E-marketplace) brokering deals between participants in the E-marketplace (e.g., a buyer and a seller, each of whom are not associated with the E-marketplace except with respect to their mutual desire to use the E-marketplace to broker a transaction), the idea of using a digital signature to assure that two or more participants can transact the deal without interference by the E-marketplace is novel and non-obvious. It is only through the use of impermissible hindsight that one of ordinary skill in the art would consider combining the use of digital signature to proved this level of security and comfort to the participants interacting via the E-marketplace. Nothing in Barzilai teaches or reasonably suggest the need for this, nor any method of doing so, and the addition of Bowman, with its generic disclosure of the existence of digital signature teaches or reasonably suggests such a use or the need for such a use. As set forth in Column 70, lines 58-67, the concern of Bowman that prompts them to consider using digital signatures is the traditional concern – to be able to confirm that the *sender* of the message actually sent the message, and not, as in the

present invention, a concern that a middleman, i.e., the E-marketplace, may have tampered with information for nefarious reasons.

Each of the claims recite the novel and non-obvious feature of providing the digitally signed information to the E-marketplace for receipt by participants other than the E-marketplace. Since each of the claims contain these elements, all of the pending claims patentably define over the prior art. Accordingly, the Applicant respectfully request the Examiner to reconsider and withdraw the rejection of the claims and issue an early Notice of Allowance.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to applicant's Deposit Account No. 09-0461.

Respectfully submitted

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Date

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